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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

060258-0264014

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on _____

Signature _____

Typed or printed name _____

Application Number

09/381,334

Filed

November 18, 1999

First Named Inventor

VIRTANEN

Art Unit

2686

Examiner

Iqbal, Khawar

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 41844
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

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February 5, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket: 060258-0264014
Client Reference: 2980022US/VK/HER



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of: VIRTANEN Confirmation Number: 3837
Application No.: 09/381,334 Group Art Unit: 2686

Filed: November 18, 1999 Examiner: Iqbal, Khawar

Title: RADIO NETWORK ACCESS MECHANISM

ATTACHMENT SHEETS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants hereby request that a panel of examiners formally review the legal and factual basis of the rejections in the above-identified application prior to the filing of an appeal brief. Appellants assert that the outstanding rejections (now on appeal by virtue of the concurrently filed Notice of Appeal) are clearly improper based both upon errors in facts and the omission of essential elements required to establish a prima facie rejection (i.e., the prior art reference fails to disclose, teach or suggest all the recited claim features).

Appellants submit that the rejection of claims 1, 2 and 8 under 35 U.S.C. 112, first paragraph is not based in fact. Rather, the rejection is premised on a blatant misunderstanding of the disclosed invention.

Specifically, the Examiner has erroneously alleged that the claim element of "accessing the mobile subscriber via the first and second network" is not described in the specification in such a way that a skilled person would have understood the inventor to have possession of the claimed invention. The Examiner has also stated his opinion that the recitation of claim 1 that it is allegedly unclear how address information is being used to access the mobile subscriber via the first and second network and that one of ordinary skill in the art would not be able to establish the claimed "accessing" without undue experimentation.

Additionally, the Examiner has alleged that the specification fails to support the wording "subscriber- specific operator."

Appellant submits that this belated 112 rejection is contrary to the proper examination of a patent application; this application has been the subject of ten Office Actions. The

allegedly unsupported features were included in response to the eighth Office Action. To the extent that support was not present in the specification at that point, the Examiner should have raised the issue then.

Nevertheless, Appellant submits that Figure 1 and its associated textual description in the specification clearly provide an enabling disclosure and even indicate commercial products available at the priority date of the present invention. Appellant submits that the 112 rejection is unclear as to what is allegedly not supported by a written description. Nevertheless, if the issue is that he does not understand the concept of "address information for accessing. . ." Appellant directs the Office to the description of such address information provided in connection with Figure 1 and page 4, lines 32-36 of Appellant's specification, which states:

A home location register HLR is also used to authenticate subscribers at the beginning of a GPRS session. It contains a definition between a subscriber's PDP (Packet Data Protocol) address (addresses) and the subscriber's IMSI (International Mobile Subscriber Identity). In a GSM network a subscriber is identified on the basis of the IMSI.

By way of example, this paragraph clearly provides support for the claim element of "the mobile subscriber data comprising address information for accessing the mobile subscriber via the first and the second network," by disclosing that such address information is stored in the HLR, but since the address information is subscriber-specific, it is part of the "subscriber data." In this example, the address information for accessing the mobile subscriber via the first and second network is the subscriber's IMSI and PDP address(es), respectively.

Appellant also directs the Office's attention to page 8, lines 15-19, which describes an embodiment of the invention as follows:

An access parameter PARAM of the invention indicates whether the subscriber has access to the GSM network, the GPRS network or to both networks. According to a first embodiment, the access parameter is maintained in the subscriber data of the home location register HLR.

Accordingly, Appellant submits that claims 1, 2 and 8 are in full compliance with 35 U.S.C. 112 and the lack of written description rejection should be withdrawn.

Claims 1-13 were rejected under 35 U.S.C. 102(e) as being unpatentable over Nordman (U.S. 6,061,346) and rejected claims 1-8 under 35 U.S.C. 102(e) as being unpatentable over Salin et al. (U.S. 6,370,390; hereafter "Salin").

At the outset, Appellant maintains that Salin is not prior art under 35 U.S.C. 102(e) because its 102(e) date is December 1, 1998, which is later than the priority date of the present application (January 28, 1998); see file history for certified English language translation of the priority application.

Appellant asserts that the remaining prior art rejection based on Nordman is improper because Nordman fails to disclose, teach or suggest all the features of the rejected claims. For example, Nordman fails to disclose teach or suggest the claimed method and data structure, in connection with a subscriber-specific access parameter which is maintained and stored and indicates, independently of the address information, whether the mobile subscriber is entitled to use the first network, the second network or both networks, as recited in independent claims 1, 2 and 8 and their respective dependent claims.

Preliminarily, Appellant notes that the Office Action remarks fail to explain which of Nordman's elements is considered equivalent to the claimed "access parameter." In fact, Nordman's disclosure does not refer to the term "parameter." Thus, Appellant is forced to speculate regarding the Office's interpretation of Nordman. As a result, Appellant believes that the Office has incorrectly concluded that Nordman's Wireless Host Identifier (WHI) is meant to correspond to the claimed access parameter.

Nordman teaches that the WHI can be stored at an HLR in addition to in a SIM. Card. However, the WHI is not used as an access parameter to indicate "whether the mobile subscriber is entitled to use the first network, the second network or both networks," as in claim 1. Contrary to the Examiner's assertions, the authentication procedure performed in Nordman (col. 7, line s36-67) does not use the WHI; rather, that passage and Nordman read in its entirety merely teach using an IMSI and "pseudo-random number of values" to confirm that the mobile terminal is permitted to communicate by way of wireless access network formed of the network infrastructure.

According to Nordman, if the authentication was successful, then, subsequently, the value of the WHI would be sent to the private IP network. In other words, the value of the WHI stored in the HLR is not used to indicate "whether the mobile subscriber is entitled to use the first network, the second network or both networks" (assuming for arguments sake that Nordman's wireless access network could be construed to correspond to Appellant's recited first network and Nordman's private IP network correspond to the Appellant's recited second network).

Further, if the Examiner were to next erroneously attempt to assert that Nordman's use of the IMSI were to anticipate Appellant's recited access parameter of claim 1, Appellant submits that the IMSI is not a parameter which indicates whether mobile subscriber is entitled to use the first network, the second network or both networks. Rather, the IMSI is used for authentication as disclosed by Nordman col. 7 lines 36-45. Thus, if the authentication is successful, the subscriber having the IMSI is entitled to use the single network that performed the authentication but provides not access privilege analysis for other networks.

Moreover, the Examiner erroneously referred to Nordman, col. 8. line 50 - col. 9. line 30 in his arguments against claim 1; however, that passage of merely discloses a logical arrangement for a wireless host to access the private IP network (col. 8. lines 43-47). Thus, Nordman fails to teach or suggest an access parameter stored in an HLR which independently of address information indicates "whether the mobile subscriber is entitled to use the first network, the second network or both networks". IMSI and WHI are not such parameters as discussed above. Moreover, because Nordman fails to teach or suggest the claimed access parameter stored in an HLR, Nordman also fails to teach or suggest a network element using such an access parameter to restrict the access of the mobile subscriber only to the first network or to the second network, as recited in the independent claims.

Thus, Nordman's WHI merely indicates whether a subscriber is entitled to use an IP network via a wireless access network. Thus, the WHI fails to indicate, independent of address information, whether the mobile subscriber is entitled to use the first network the second network or both networks, as recited in independent claim 1 and its dependent claims.

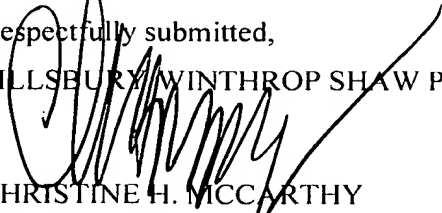
Thus, Nordman fails to disclose anything beyond a conventional authentication information, which indicates whether a subscriber is entitled to use a single network. Accordingly, Nordman fails to disclose teach or suggest the claimed method and data structure, in connection with a subscriber-specific access parameter which is maintained and stored and indicates, independently of the address information, whether the mobile subscriber is entitled to use the first network, the second network or both networks, as recited in independent claims 1, 2 and 8 and their respective dependent claims.

Therefore, it is respectfully requested that the panel return a decision concurring with Applicant's position and eliminating the need to file an appeal brief because there are clear legal and/or factual deficiencies in the appealed rejections.

VIRTANEN -- 09/381,334
Client/Matter: 060258-0264014

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,
PILLSBURY WINTHROP SHAW PITTMAN LLP



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